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REMARKS

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested. Applicant asserts that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

Status of Claims

Claims 1 - 12 remain pending in the application. New claims 24 - 26 have been added. Claims 1 - 12 have been rejected. Claim 1 has been voluntarily amended for clarification only. This amendment is not being made for reasons of patentability as explained below. Applicants respectfully submit that the new claims and the amendment add no new matter.

Interview Summary

Applicant would like to thank Examiner Connie P. Johnson and Supervisory Examiner Cynthia Kelly for granting and participating in a Telephone Interview on December 12, 2006 with Applicants' representatives, Caleb Pollack and Naomi Liver.

In the Interview, the rejection of claim 1 was discussed. Applicants' representatives have explained the differences between claim 1 and the teaching of the Teng reference (US 6,245,486). The Examiner has concluded the interview by stating that she would review the reference again. Agreement was not reached. The Examiner then called and requested that the arguments raised in the interview be presented in the response to the Office Action.

CLAIM REJECTIONS

35 U.S.C. § 103 Rejections

In the Office Action, the Examiner rejected claims 1 - 12 under 35 U.S.C. § 103(a), as being unpatentable over Teng (US 6,245,486) in view of Crawford et al. (US 4,430,366).

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Applicants respectfully traverse the rejection of claims 1 - 12 in view of the remarks that follow.

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)" [MPEP §2142]

Claim 1 recites: "a base layer; a laser-absorbing layer over said base layer ...; and a coating layer over said laser-absorbing layer..., wherein said printing member is capable of being imaged such that selective areas of said coating layer and of said laser-absorbing layer are removed to expose said base layer".

Without conceding the appropriateness of the combination, Applicants respectfully submit that the combination of Teng and Crawford does not meet the requirements of an obviousness rejection, in that the combination fails to teach or suggest all the elements of the claimed invention.

Teng does teach or fairly suggest at least a printing member comprising "a base layer; a laser-absorbing layer over said base layer ...; and an image-bearing coating layer over said laser-absorbing layer... wherein upon imagewise exposing said printing member selective areas of said coating layer and of said laser-absorbing layer are removed to expose said base layer", as recited in claim 1.

The Teng reference discloses a substrate; an image-bearing photosensitive layer over the substrate; and a laser-ablatable mask layer over the image-bearing layer.

As taught by the Teng reference, the mask layer (laser-absorbing layer) must be completely removed prior to printing. First, the plate is exposed to IR laser to selectively remove areas of the mask layer. Then, the entire plate is exposed to actinic radiation to cause

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hardening or solubilization of the now exposed areas of the intermediate photosensitive layer and lastly, the plate is exposed again to IR laser radiation to remove the remaining of the mask layer. Accordingly, Teng does not teach or suggest "said printing member is capable of being imaged such that selective areas of said coating layer and of said laser-absorbing layer are removed to expose said base layer", as recited in claim 1.

Moreover, the office action contends that the "laser-ablatable sub-layer" of Teng meets the limitation of a coating layer. Applicants respectfully assert that the "laser-ablatable sub-layer" taught by Teng is likewise completely removed prior to printing, in contrast to the limitation of "wherein said printing member is capable of being imaged such that selective areas of said coating layer and of said laser-absorbing layer are removed to expose said base layer", recited in claim 1.

In the Office Action, the Examiner admits that "Teng does not teach the laser-ablatable layer and the substrate have different affinity for ink" and contends that "it would have been obvious to one of ordinary skill in the art that a hydrophilic substrate requires a laser-ablatable layer with ink-receptance to effectively develop the printing plate as taught by Teng". As discussed above, the laser-ablatable layer taught by Teng is a mask layer that is entirely removed prior to printing. Accordingly, a person of ordinary skill in the art would realize that there is no need for the laser-ablatable layer and the substrate of Teng to have different affinity for ink. Moreover, the proposed modification of the Teng reference would completely change the principle of operation of the printing member of Teng.

Additionally, the office action did not show any reasoning why a person skilled in the art would be motivated to modify the Teng teachings of a printing member having a mask-ablatable layer into a printing member as claimed in claim 1.

The Crawford reference is directed to a process for the vacuum deposition of metal or metal oxide layers on substrates and not to printing plates and accordingly cannot cure the deficiencies of the Teng reference described above.

The Office Action further concludes that it would have been obvious to one having ordinary skill in the art at the time to use the aluminum composition of Crawford in the printing plate of Teng because the layer formed by Crawford meets the limitation of a laser

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ablatable mask layer in that it is capable of absorbing UV light and capable of being removed after exposure to form an effective aluminum/aluminum oxide coating.

Applicants respectfully assert that the printing plate as claimed in claim 1 does not comprise "a laser-ablatable mask layer capable of being removed", and therefore the Office Action did not make out a prima facie case of obviousness, because it provides no evidence of a suggestion or motivation to combine the references to form what is claimed. Without conceding the appropriateness of the combination, Applicants respectfully submit that the combination of Teng and Crawford fails to teach or suggest all the elements of the claimed invention. Accordingly, the combination of Crawford and Teng does not render claim 1 obvious.

For the foregoing reasons, Applicant respectfully submits that independent claim 1 is not made obvious by the combination of Crawford and Teng.

In view of the above, applicants respectfully submit that claim 1 is allowable. Claims 2 - 12 depend directly or indirectly from claim 1, and thereby include all the limitations of claim 1 as well as additional distinguishing elements. Therefore, claims 2 - 12 are patentable for at least the reasons discussed above with regard to claim 1. In view of the above remarks, Applicants respectfully request that the above rejections of claims 1 - 12 under 35 U.S.C. § 102(b) be withdrawn.

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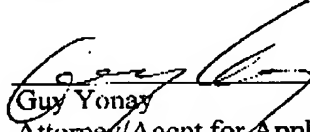
CONCLUSION

In view of the foregoing amendments and remarks, the pending claims are deemed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this paper to deposit account No. 50-3355.

Respectfully submitted,


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